



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,293	08/09/2001	Robert Hornung	IND-109.1	3317

20028 7590 09/23/2003

LAW OFFICE OF BARRY R LIPSITZ
755 MAIN STREET
MONROE, CT 06468

[REDACTED] EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
1733	8

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant No.	Applicant(s)
	09/925,293	HORNUNG ET AL.
	Examiner Jessica L. Rossi	Art Unit 1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Interview Summary, 9/15/03.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>7</u> .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A (appears to be claim 3 and claims 2, 4-25, 39-42), drawn to the second pane being mounted to the first pane via an adhesive as disclosed on p. 5, 2nd paragraph – p. 7, 3rd paragraph and as shown in Figures 1-5, 7-10, 12-14, and 17-18.

Species B (appears to be claim 26 and claims 10-12, 19-24, 27-42), drawn to the second pane being mounted on the first pane via a spacer as disclosed on p. 7, 4th paragraph – p. 8, line 15, p. 30, lines 15-22, and as shown in Figures 20A-28.

***Note: upon election of Species A or B, a further subspecies and sub-subspecies election must be made; must elect one sub-subspecies within each subspecies (i.e. elect Species A, then elect sub-subspecies Aix of subspecies Ai, sub-subspecies Aiix of subspecies Aii, sub-subspecies Aiiix of subspecies Aiii, sub-subspecies Aivx of subspecies Aiv).**

Within Species A:

Subspecies Ai

Sub-subspecies Aix (appears to be claim 13), drawn to providing setting blocks on the sash frame to position at least one of the panes as disclosed on p. 20, lines 5-12 and as shown in Figures 3-4.

Sub-subspecies Ai_y (appears to be claims 18, 25), drawn to at least one of the panes being embedded in the adhesive as disclosed on p. 20, lines 5-12 and as shown in Figure 7.

Subspecies Aii

Sub-subspecies Aiix (appears to be claim 15), drawn to mounting the outside surface perimeter of the first pane to the support surface via an adhesive that is applied to a portion of the support surface by co-extrusion with a sash profile used to fabricate the sash frame as disclosed on p. 6, line 33 – p. 7, line 7.

Subspecies Aiiy (appears to be claim 16), drawn to mounting the outside surface perimeter of the first pane to the support surface via an adhesive that is applied to a portion of the support surface by extrusion after fabrication of the sash frame as disclosed on p. 6, line 33 – p. 7, line 7.

Sub-subspecies Aiiiz (appears to be claim 17), drawn to applying an adhesive to a portion of the outside surface perimeter of the first pane to mount the pane to the support surface.

Subspecies Aiii

Sub-subspecies Aiiix (appears to be claim 23), drawn to applying an adhesive between the glazing bead and an adjacent pane as disclosed on p. 31, lines 1-2.

Sub-subspecies Aiiiy (appears to be claim 24), drawn to installing a gasket between the glazing bead and an adjacent pane as disclosed on p. 31, lines 1-2.

Subspecies Aiv

Sub-subspecies Aivx (appears to be claim 39), drawn to the glazing bead comprising a rigid strip as disclosed on p. 8, lines 6-10.

Sub-subspecies Aivy (appears to be claim 40), drawn to the glazing bead comprising a flexible adhesive as disclosed on p. 8, lines 6-10.

Within Species B:

Subspecies Bi

Sub-subspecies Bix (appears to be claim 28), drawn to partially filling the cavity from the spacer toward the sash frame without the adhesive contacting the inside perimeter as disclosed on p. 7, lines 18-28 and shown in Figure 12.

Sub-subspecies Biy (appears to be claim 29), drawn to completely filling the cavity from the spacer to the inside perimeter with the adhesive contacting the inside perimeter as disclosed on p. 7, lines 18-28 and shown in Figure 14.

Subspecies Bii

Sub-subspecies Biix (appears to be claim 30), drawn to the edges of the panes being embedded in the adhesive as shown in Figures 20E-F.

Sub-subspecies Biyy (appears to be claim 31), drawn to using a portion of the spacer as a setting block for at least one of the panes as shown in Figure 23.

Subspecies Biii

Sub-subspecies Biix (appears to be claim 34), drawn to providing a muntin bar integral with the spacer as shown in Figure 26.

Sub-species Biiiy (appears to be claims 35-36), drawn to providing the spacer with a mounting element for a muntin bar as shown in Figure 27.

Subspecies Biv

Sub-subspecies Bivx (appears to be claim 23), drawn to applying an adhesive between the glazing bead and an adjacent pane as disclosed on p. 31, lines 1-2.

Sub-subspecies Bivy (appears to be claim 24), drawn to installing a gasket between the glazing bead and an adjacent pane as disclosed on p. 31, lines 1-2.

Subspecies Bv

Sub-subspecies Bvx (appears to be claim 39), drawn to the glazing bead comprising a rigid strip as disclosed on p. 8, lines 6-10.

Sub-subspecies Bvy (appears to be claim 40), drawn to the glazing bead comprising a flexible adhesive as disclosed on p. 8, lines 6-10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a **listing of all claims readable thereon**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. *Note rejoinder of species, subspecies, and sub-subspecies will be considered upon the discovery of allowable subject matter, depending on the basis thereof.*

3. A telephone call was made to Mr. Lipsitz on 9/15/03 to inform Applicants that a restriction was being mailed out for the reasons set forth in the Interview Summary dated 9/15/03, paper no. 7.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/925,293
Art Unit: 1733

Page 7

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733

JLR

jlr

mwb
Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700